REMARKS

In view of the following remarks, the Examiner is respectfully requested to reconsider and withdraw the restriction requirement and to proceed with examination of the application on the merit as filed.

Restriction may be required if two or more "independent and distinct" inventions are claimed in one application. 35 U.S.C. § 121; 37 C.F.R. § 1.141. However, Applicants respectfully submit that the main purpose of Rule 141 is to facilitate the search in considering the patentability of the claimed subject matter and to avoid a situation that requires separate and diverse searches to be conducted on claims directed to independent (unrelated) subject matter. Inventions are deemed "independent" if there is no disclosed relationship and/or if the inventions are unconnected in design, operation or effect. See M.P.E.P. § 802.01.

The Patent Office practice as set forth in the MPEP requires that search and examination of the entire application must impose a serious burden on the Examiner before a proper requirement for restriction may be made. MPEP 803, page 800-4, col. 1 (third paragraph in MPEP 803). Thus, the Patent Office encourages the assertion that examination of the entire application may take place where such search and examination can be made without serious burden, even though separate, non-overlapping searches may be required.

As the Examiner correctly stated, inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product.

However, the Examiner's assertion that an array of invention II may be used in different method, for example, to determine SNPs, to design drugs, to screen tissues/cells for gene expression, is not in keeping with the spirit and intent of the good restriction practice because of the materiality of the distinctions asserted.

Claim 4, the independent claim of Claim II, is directed to an oligonucleotide array elicited in response to inteferon β treatment. It is the Examiner's contention that this oligonucleotide array may be used for things other than evaluating the efficacy of inteferon β treatment. Applicants submit that whatever else said array may be used for, the claim as written specifically refers to not just any oligonucleotide arrays, but specifically those elicited in response to inteferon β treatment. Whatever different process the product of Claim II inventions may be subjected to, such processes will invariably be connected with inteferon β

therapeutics. Said process, if different, would not be materially different for the purposes of conducting a search on the totality of claims of this Application.

The Examiner further asserts that restriction is proper because the claims of Invention I may use different kind of an array, e.g., probes may be suspended and not immobilized on the substrate. Applicants contend that whether the probes are suspended or immobilized is immaterial for the purposes of conducting a search because a search for the probes would invariably capture probes be there suspended or immobilized. Because, the distinction the Examiner proffers are directed to incidental collateral issues that would not have searchability consequences, Applicants do not believe that burden anticipated by the Examiner, if any, is material enough to justify the restriction requirement.

Applicants further ask the Examiner to re-consider the claim scheme as to their inter-relatedness. The so called Inventions of Group I are directed to a method for evaluating the efficacy of interferon β treatment by reference to an empirically determined library of oligonucleotide arrays comprising proteins/peptides elicited by interferon β treatment. The so called Inventions of Group II are directed to said empirically determined library. Because the two inventive groups are unified by the same inventive concept – namely evaluating the efficacy of interferon β treatment, Applicants believe that whatever burden imposed by the Examiner in conducting a search for both groups would not support the current restriction requirement as a matter of best practices promulgated in the MPEP.

If the restriction requirement is improper, the requirement to elect species is more so because the probes of claims 1 to 6, to which the Examiner directed her species are described in the conjunctive and not in the disjunctive. Claim 1 for instance recites the use of at least one interferon induced protein gene, at least one interferon regulation factor gene, and at least one chemokine gene. The conjunctive nature of the claims makes it very unlikely that the Examiner will encounter any additional burden in Examining the claims as written. For that at least, Applicants ask that the species election be withdrawn.

Should there be any outstanding issues requiring discussion that would further the prosecution and allowance of the above-captioned application, the Examiner is invited to

contact the Applicant's undersigned representative at the address and phone number indicated below.

Respectfully submitted,

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